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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/509,888

10/01/2004

Andrew J. Mayhew

36-1859

9785

23117

7590

06/23/2009

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EXAMINER

SINGH, SUNIL

ART UNIT

PAPER NUMBER

3672

MAIL DATE

DELIVERY MODE

06/23/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/509,888	<b>Applicant(s)</b> MAYHEW ET AL.	
	<b>Examiner</b> Sunil Singh	<b>Art Unit</b> 3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15, 17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) 6 and 8-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 14, 15, 17 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 17 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17 is confusing because it is not clear if applicant is claiming the “cable”. Second it is not clear if applicant is claiming the method of removing the cable. It should be noted that it is unclear if applicant is relying on method steps for patentability in an apparatus claim. Furthermore, it should be noted that the “cable” is not part of the apparatus.

With regards to claim 18, claim 18 appears to be directed to the method of insertion a sub-duct; however, it does not positively recite any method steps.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 1-5, 7,14,17 are rejected under 35 U.S.C. 102(b) as being anticipated by Miyazaki et al. (US 5108228).

Miyazaki et al. discloses a sub-ducting apparatus comprising a sub-duct (1) and a remotely operable path-finding element (member 2 and part of member 1 near member 2) arranged to facilitate insertion of the sub-duct into a duct (c ). The path-finding element is capable of being selectively activated (this is the case because the user regulates how much heat and pressure are applied to the tube (1), which includes the part of member 1 near member 2). The path-finding element is capable of negotiating a path through an obstruction in the duct that can affect insertion of the sub-duct (this is the case since member 2 has a dome shape). The sub-duct is an elongate sleeve. The path- finding element is a path-finding head. The head is detachable. The head is outwardly deformable (this is the case when the device is inflated). The head is outwardly deformable at the front end. Means for advancing (see col. 5 lines 30-40). With regards to claim 17, as best understood, it appears that the sub-duct (1) is capable of being sleeved over a cable via member (2a).

5. Claims 1-4,14,17 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent abstract (05015026).

Japanese Patent abstract discloses a sub-ducting apparatus comprising a sub-duct (1b) and a remotely operable path-finding element (3) arranged to facilitate insertion of the sub-duct into a duct (2 ). The path-finding element is capable of being selectively activated (this is the case because the user operates member 3). The path-finding element is capable of negotiating a path through an obstruction in the duct (this is the

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case since member 3 is capable of removing dirt etc. that lines member (2)). The sub-duct is an elongate sleeve. The path-finding element is a path-finding head. The head is detachable. Means for advancing (see col. 5 lines 30-40).

With regards to claim 17, as best understood, it appears that the sub-duct (1b) is capable of being sleeved over a cable (1a)(see Figures).

6. Claims 1-4,14,17 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Born (US 5988188).

Born discloses a sub-ducting apparatus comprising a sub-duct (14,26, see Figs. 1,2,3) and a remotely operable path-finding element (18, see Figs.8,9a-d) arranged to facilitate insertion of the sub-duct into a duct (12). The path-finding element is capable of being selectively activated (this is the case because the user operates member 18). The sub-duct is an elongate sleeve (see Fig. 2). The path-finding element is a path-finding head. The head is detachable. Means for advancing (see Figs. 4a,b). Obstruction (see Figs. 1,8,10,12,13).

With regards to claim 17, as best understood, it appears that the sub-duct is capable of being sleeved over a cable (see Fig. 2).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Born in view of Griffioen et al. (US 5639183).

Born discloses the invention substantially as claimed. However, Born is silent about the sub-duct sleeving over a cable within a duct for subsequent removal of the cable from the duct. Griffioen et al. teaches a sub-duct (21) sleeving over a cable (22) (see Fig. 4). It would have been considered obvious to one of ordinary skill in the art to modify Born to include the sub-duct sleeving over a cable arrangement as taught by Griffioen et al. in order to provide the apparatus of Born with additional capabilities.

With regards to the removal step, it would have been considered obvious to remove the cable in the event the cable is damaged.

### ***Response to Arguments***

9. Applicant's arguments filed 6/8/09 have been fully considered but they are not persuasive. Applicant argues that Miyazaki et al. plug (2) is not a "path-finding element". The examiner disagrees. As member (1) is advanced the "dome shape" of member (2) would guide the direction of member (1); therefore member (2) is considered a "path-finding element". Applicant persistently argues how his invention functions but has yet establish what are the claimed structural differences between the claimed subject matter and Miyazaki et al. Since the claimed structural limitations are taught by Miyazaki et al., Miyazaki et al. would then be capable of performing the intended functions. For example, member (2) is capable of negotiating a path through an

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obstruction (e.g. dirt/debris lining member ( c ) ) that would affect insertion of member (1) since it is provided with a domed shape.

With regards to Fujikura, applicant persistently argues how his invention functions but has yet establish what are the claimed structural differences between the claimed subject matter and Fujikura. Since the claimed structural limitations are taught by Fujikura, Fujikura would then be capable of performing the intended functions. For example, member (3) is capable of negotiating a path through an obstruction (e.g. dirt/debris lining member (2) ) that would affect insertion of member (1b) since it is the user that would determine when to activate member (3).

With regards to Born, applicant argues that the obstruction (24) affects water flow and not the sub-duct. The examiner disagrees. Obstruction (24) is in the pathway of travel of member (14); therefore obstruction (24) affects insertion of sub-duct (14).

With regards to Born, applicant persistently argues how his invention functions but has yet establish what are the claimed structural differences between the claimed subject matter and Born. Since the claimed structural limitations are taught by Born, Born would then be capable of performing the intended functions. For example, member (18) is capable of negotiating a path through an obstruction (24) that would affect insertion of member (14) since it is the user that would determine when and how to activate member (18) to negotiate through the obstruction.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunil Singh whose telephone number is (571) 272-7051. The examiner can normally be reached on Monday through Friday 10:30 AM - 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (571) 272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sunil Singh/  
Primary Examiner, Art Unit 3672

Sunil Singh  
Primary Examiner  
Art Unit 3672

SS

6/20/09